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EXAMINER
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FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/597,131

Applicant(s)

PHILYAW, JEFFRY JOVAN

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-22 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Acknowledgements*

1. Applicant(s)' amendment filed June 24, 2004 is acknowledged. Accordingly, claims 1-22 remain pending.
2. The Examiner again notes that currently Invention Group I (claims 1-11) is not patentably distinct from Invention Group II (claims 12-22). A restriction between the inventions at this time would be improper. Applicant is again reminded that should future amendments make the claims patentably distinct or if Applicant argues the claims *are* patentably distinct, a restriction between the two inventions may follow.
3. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.

### *Specification*

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP §608.01(o); and MPEP §2181.

Correction of the following is required:

- a. In claim 22, the “means for transferring said extracted encoded information from said MRC . . . .”

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***Claim Rejections - 35 USC §112 2<sup>nd</sup> Paragraph***

5. The following is a quotation of the 2<sup>nd</sup> paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-22 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claim 12-22 are indefinite because Applicant has not clearly linked and associated any corresponding structure with the claimed “means for transferring said extracted encoded information from said MRC . . . .” Applicant is reminded, “For claim clauses containing functional limitations in ‘means for’ terms pursuant to §112 ¶ 6, the claimed function and its supporting structure in the specification must be presented with sufficient particularity to satisfy the requirements of §112 ¶ 6. *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1747 (Fed. Cir. 2001) (citations omitted). In other words, “[f]ailure to describe adequately the necessary structure, material, or acts corresponding to a means-plus-function limitation in the written description means that the drafter has failed to comply with Section 112, Para. 2.” *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1380 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) citing *In re Dossel*, 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997)).

B. In claims 1 and 12, it is unclear what the “with the extraction operation of said extraction circuit” modifies. It is the Examiner’s position that in accordance with the precepts of English grammar, the phrase “with the extraction operation of said extraction circuit” modifies the user.

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*Claim Rejections - 35 USC §102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 12-22, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Ogasawara (U.S. 6,123,259). Ogasawara discloses the following: a UPC code (column 11, last paragraph); an extraction circuit (within scanner 15); a temporary buffer (inherent in any CPU); an identification device (device that identifies the product scanner); a retail processing system (inherent); ownership of the article is transferred after receiving encoded information (and payment); the scanner has a unique id (column 10, paragraph starting on line 25); the personal scanner is wireless (wireless to the main store server 50 and its database); the user has an account set up for them prior to receiving the scanner (inherent); the scanner has at least some memory (which is a temporary buffer).

9. Claims 1-5 and 12-16, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §102(e) as being clearly anticipated by Barnett (U.S. 6,343,276).

10. Claims 1-11, as understood by the Examiner, are also rejected under 35 U.S.C. §102(e) as being anticipated by Ogasawara. Because Group I is not patentably distinct from Group II, the patentability of Group I stands or falls with the patentability of Group II.

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***Claim Rejections - 35 USC §103***

11. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 12-22 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Ogasawara.<sup>1</sup> It is the Examiner's principle position that the methods are anticipated because of the reasons stated above.

However, even if not anticipated, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ogasawara to include the claimed method. Because the prior art discloses all the structure necessary to perform the claimed functions, one of ordinary skill in the art would find the claimed method to be obvious in view of the disclosed structure as disclosed in claims 12-22.

13. Claims 1-11 are also rejected under 35 U.S.C. §103(a) as being unpatentable over Ogasawara. Because Invention I (claims 1-11) are not patentably distinct from Invention II (claims 12-22), the patentability of claims 1-11 with regards to Ogasawara stands or falls with the patentability of claims 12-22. See Paragraph 2, supra.

14. Additionally, it is the Examiner position that to one of ordinary skill in this art, it is old and well known that bar codes contain useful information including but not limited to: date of manufacture; shelf life; place of manufacture; intended distribution route; batch number;

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<sup>1</sup> See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

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government specs; size, weight, color, etc.; pricing, discount, commission, tax, and other accounting information; automatic reordering instructions; serial numbers, and so forth. See *e.g.* Storch et. al. (U.S. 5,548,110).

15. For due process purposes, the Examiner again confirms that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner again notes the following factual findings as first discussed in the previous Office Actions.<sup>2</sup> First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements<sup>3</sup> with the required clarity, deliberateness, and precision.<sup>4</sup> Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked,<sup>5</sup> Applicant's three (3) responses have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance

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<sup>2</sup> See the First Non Final Office Action mailed April 23, 2002, Paper No. 9, Paragraph No. 16; the First Final Office Action mailed December 17, 2002, Paragraph No. 9; and the Second Non Final Office Action mailed December 24, 2003, Paper No. 17, Paragraph No. 14.

<sup>3</sup> "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>4</sup> "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

<sup>5</sup> See Note 2.

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with 37 C.F.R. §1.111(b) (*i.e.* Applicant did not argue lexicography *was* invoked). Forth and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation to be his own lexicographer. Finally, after receiving express notice of the preceding factual findings and conclusions, Applicant's latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b). Moreover, Applicant's latest response—while fully considered by the Examiner—has not changed the Examiner's conclusion that Applicant has decided not to be his own lexicographer. Therefore (and except for the claim limitations interpreted under 35 U.S.C. §112 6<sup>th</sup> paragraph, *infra*), the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is again confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.<sup>6</sup>

### ***35 U.S.C. §112 6<sup>th</sup> Paragraph***

16. The pending system claims (*e.g.* claim 12-22) are combination claims made of old and possibly new elements. See *e.g. Clearstream Wastewater Sys. v. Hydro-Action, Inc.*, 206 F.3d 1440, 1446, 54 USPQ2d 1185, 1190 (Fed. Cir. 2000)(noting that there is "a general rule that combination claims can consist of combinations of old elements as well as new elements"). Moreover, in combination claims, there is no essential element or "gist" of the invention. *Cooper*

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<sup>6</sup> See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]"



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*Cameron Corp. v. Kvaerner Oilfield Products Inc.*, 62 USPQ2d 1846, 1850 (Fed. Cir. 2002)

(noting that “there is no legally recognizable or protected ‘essential’ element, ‘gist’ or ‘heart’ of the invention in a combination patent.”). In light of this fact and after further review of the specification, the Examiner finds that the means-plus-function limitation(s) in claims 12-22 are *not* solely determinative of patentability. In other words, the Examiner finds that the means-plus-function limitation in the claims is not the *only* point of novelty. The Examiner therefore begins his §112 6<sup>th</sup> paragraph analysis with this presumption.

17. If Applicant disagrees with this presumption, the Examiner respectfully requests Applicant to expressly traverse the Examiner’s presumption in his next properly filed response and provide appropriate arguments in support thereof. Failure by Applicant to also address this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant to maintain the presumption that the means-plus-function limitations are *not* the claims’ only point of novelty.

18. The following is a more detailed analysis of 35 U.S.C. §112 6<sup>th</sup> paragraph limitation now pending.

#### **Means Phrase #1**

##### ***Invocation***

19. It is the Examiner’s position that the phrase “means for transferring said extracted encoded information from said MRC and said unique identification information to said retail processing system in response to the operation of said extraction circuit extracting said encoded information from said MRC” as recited in claim 12 (“Means Phrase #1”) is an attempt by Applicant to invoke 35 U.S.C. §112 6<sup>th</sup> paragraph in claim 12.

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**Invocation - Prong 2:**

20. Second, in accordance with MPEP §2181, the Guidelines, and *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001), the Examiner finds that Applicant recites a corresponding function to the means—"transferring said extracted encoded information from said MRC and said unique identification information to said retail processing system."

The Examiner notes that when determining the function recited "[u]nless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by that language." *Telemac Cellular Corp. v. Topp Telecom Inc.*, 58 USPQ2d 1545, 1550 (Fed. Cir. 2001). Because nothing in the specification suggests otherwise, the function as found in the Means Phrase #1 will have its ordinary meaning.

**Invocation - Prong 3:**

21. Third, in accordance with MPEP §2181, the Guidelines, and *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 704, 48 USPQ2d at 1880, 1887 (Fed. Cir. 1998), the means-plus-function clause must not recite sufficient definite structure for performing that function.

In our case, Means Phrase #1 does not recite the structural elements which perform the function. In determining whether the presumption of invocation is rebutted, "the focus remains on whether the claim ... recites sufficiently definite structure." *Id.* Furthermore, sufficient structure does not require an exhaustive recitation—only structure to perform entirely the claimed function.

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*Rodime PLC v. Seagate Technology Inc.*, 174 F.3d 1294, 1304, 50 USPQ2d 1429, 1436 (Fed. Cir. 1999). In this case, the recited structure does not perform the recited function.

Because of the above, the Examiner finds that Means Phrase #1 invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

***Corresponding Structure, Material, or Acts***

22. In accordance with MPEP §2181, the Guidelines (section "II") and *Medtronic, Inc., v. Advanced Cardiovascular Systems, Inc.* 248 F.3d 1303, 58 USPQ2d 1607, 1614 (Fed. Cir. 2001), "[t]he next step is to determine the corresponding structure described in the specification and equivalents thereof. Structure disclosed in the written description is 'corresponding' to the claimed means under 35 U.S.C. 112 6<sup>th</sup> paragraph only if the structure is clearly linked by the written description . . . ." *Id.*

23. One of ordinary skill in the art however can not link and clearly associate the corresponding structure in Means Phrase #1. Neither the figures nor the specification clearly links or associates the means plus function claim limitation to any corresponding structure.

***Response to Arguments***

24. Applicant's arguments filed with his amendment have been fully considered but they are not persuasive.

***Prior Art***

25. Applicant argues that "Claim, 12 requires that there be some identification device for associated unique identification information with the extraction operations of said extraction

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circuit. . . . Applicant believes that the system of Ogasawara does not associated the unique identification information with the extraction circuit.”<sup>7</sup> First, claim 12 states the “identification information [be] associated with the user” and not the extraction circuit. Applicant’s point is therefore immaterial. As Judge Clevenger has so eloquently summarized these types of arguments, “The invention disclosed in [Applicant’s] written description may be outstanding in its field, but the name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Applicant’s argument has been considered but is not persuasive.

26. Regarding Barnett, Applicant also argues that there is no unique identification associated with the portable unit. Again, this is not found in the claims. Even if the claims recited such features, identifying the portable unit is disclosed. Moreover, it is the Examiner’s position that to one of ordinary skill in this art, identification of the remote unit is old and well known. See *e.g.* Swartz et. al. (U.S. 5,923,735).

### ***Lexicography***

27. Applicant again states that “it is believed that the claims can clearly be interpreted in view of the specification.” Other than lexicography and 112 6<sup>th</sup> paragraph, both addressed above, the Examiner respectfully disagrees. Applicant arguments apply to inter partes litigation—not ex parte examination.

28. Applicant gives the example of a diode and states that if a diode was defined, “the specification would certainly not define a diode as being anything other than what it clearly is.”<sup>8</sup> The Examiner respectfully disagrees. The Examiner recognizes that a claim term may not be

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<sup>7</sup> Applicant’s Remarks, Page 7.

<sup>8</sup> Applicant’s Remarks, Page 10.

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given a meaning repugnant its usual meaning. *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) (holding that the term “perpendicular” was not allowed to mean “parallel.”); *In re Hill*, 161 F.2d 367, 73 USPQ 482, 484 (CCPA 1947) (a definition may not be given a meaning repugnant its usual meaning); and MPEP §2173.05(b) subsection titled “A Term May Not Be Given a Meaning Repugnant to its Usual Meaning.” However, an applicant may redefine a claim term such as ‘diode’ away from its ordinary meaning.

29. This ‘redefined term’ or lexicographic definition is not limited by known usages either. The redefined term or lexicographic definition may be *contrary to* or *inconsistent with* one or more of the term’s ordinary meanings. “It is a well-established axiom in patent law that a patentee is free to be his or her own lexicographer and thus may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings.” *Hormone Research Found., Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1563, 15 USPQ2d 1039, 1043 (Fed. Cir. 1990). The redefined term or lexicographic definition may also *expand* or *further limit* the known ordinary and accustomed meanings. “A patent applicant may consistently and clearly use a term in a manner either more or less expansive than its general usage in the relevant art, thereby expanding or limiting the scope of the term in the context of the patent claims.” *Alloc Inc. v. ITC*, 68 USPQ2d 1161, 1165 (Fed. Cir. 2003). Therefore Applicant’s diode example is not on point.

30. Finally, Applicant’s confusion is acknowledged since Applicants state that “the undersigned is unclear as to exactly what the Examiner wants.” As noted above, the Examiner is just reconfirming that Applicant has not intended to be his own lexicographer. See Paragraph 15, *supra*. The following may help Applicant understand the Examiner’s position.

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31. First and to be clear, the Examiner has never *required* Applicant to be his own lexicographer. It is Applicant's burden to define their invention, not the Examiner's.<sup>9</sup> In complying this burden, Applicant is reminded that it is Applicant—and *not* the Examiner—who drafted the claims, specification, and drawings and it is therefore *Applicant* who must decide whether or not to be his own lexicographer.<sup>10</sup> Along the same line of reasoning, whether or not Applicant chooses this or that particular method of claim construction (*e.g.* lexicography or 35 U.S.C. §112 6<sup>th</sup> paragraph) is also completely within Applicant's discretion.

32. Second, Applicant is reminded that claim terminology is fixed upon filing. See *Middleton Inc. v. Minnesota Mining and Manufacturing Co.*, 311 F.3d 1384, 1389, 65 USPQ2d 1138, 1142 (Fed. Cir. 2002) ("The meaning of a patent term, however, is not subject to revision . . . . The meaning of patent terms depends on the usage of those terms in context by one of skill in the art *at the time of application*. [Emphasis added.]"); *Wiener v. NEC Elecs., Inc.*, 102 F.3d 534, 539, 41 USPQ2d 1023, 1027 (Fed. Cir. 1996) ("Ultimately, a court must construe the claim language according to the standard of what those words would have meant to one skilled in the art *as of the application date*. [Emphasis added.]")(overruled on other grounds in *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454-55, 46 USPQ2d 1169, 1173 (Fed. Cir. 1998) (en banc)); *Plant Genetic Systems N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1345, 65 USPQ2d 1452, 1460 (Fed. Cir. 2003)("We hold that the district court did not ignore the plain meaning of the claims, but properly gave objective meaning to them as they were understood *at the time the patent application was*

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<sup>9</sup> *In re Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029 (quoting 35 U.S.C. §112 2<sup>nd</sup> paragraph, "It is the applicants' burden to precisely define the invention, not the PTO's.").

<sup>10</sup> See *e.g. Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 USPQ 1025, 1031 (Fed. Cir. 1984) (noting that "It is the inventor applying for a patent who is permitted to be his own lexicographer," not the examiner).

*filed*. [Emphasis added.]”); and *Kopykake Enterprises Inc. v. Lucks Co.*, 264 F.3d 1377, 1383, 60 USPQ2d 1124, 1127 (Fed. Cir. 2001) (“[W]hen a claim term understood to have a narrow meaning when the application is filed later acquires a broader definition, the literal scope of the term is limited to what it was understood to mean at the time of filing.”). So once an applicant files his or her specification, the meaning of *all* claim terms—both lexicographic and non-lexicographic—are fixed. While the meaning may be ‘uncovered’ or ascertained during either ex parte examination<sup>11</sup> or inter partes litigation,<sup>12</sup> the meaning of claim terms nevertheless remains fixed. Obviously the failure to construe a claim during either ex parte examination or inter partes litigation does not change the fact that the meaning of claim terms is fixed upon filing. And terms or definitions that actually *change* claim meaning by their inclusion *after* filing the filing date of the application are improper under either 35 U.S.C. §112 1<sup>st</sup> paragraph and/or 35 U.S.C. §132 since it is axiomatic that any *change* from an initial meaning would clearly constitute new matter.

33. Third, the Examiner recognizes that drafting patent applications is a complicated process requiring the drafter to consider many complex issues.<sup>13</sup> However this does not relieve the drafter of deciding whether or not to be their own lexicographer and if affirmative, unequivocally stating those definitions in the specification. Such definitions and associated issues must be contemplated

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<sup>11</sup> See *e.g. In re Bass*, 314 F.3d 575, 577-78, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (noting that “Bass chose to define ‘motorized sports boat’ in the specification. He cannot change or modify that definition on appeal.”).

<sup>12</sup> See *e.g. Jack Gluttman, Inc. v. Kopykake Enterprises, Inc.*, 302 F.3d 1352, 1360, 64 USPQ2d 1302, 1307 (Fed. Cir. 2002) (“Where, as here, the patentee has clearly defined a claim term, that definition usually is dispositive”).

<sup>13</sup> See *e.g. Johnson & Johnston Associates Inc. v. R.E. Service Co.*, 285 F.3d 1046, 1069, 62 USPQ2d 1225, 1241 (Fed. Cir. 2002), Newman, J., dissenting (“Patentees often must draw lines in order to claim their invention with specificity.”).

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*prior to* filing the patent application. See *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 21 USPQ2d 1383 (Fed. Cir. 1992) noting that for lexicography and quoting *Lear*, “the place to do so is in the specification of the inventor’s application, and the time to do so is *prior to* that application acquiring its own independent life as a technical disclosure through its issuance as a United States patent. [Emphasis added.]” *Intellicall*, 952 F.2d at 1388, 21 USPQ2d at 1386.

34. Having established that claim terms are fixed upon filing and that Applicant is the master of his domain, the Examiner has simply required that if Applicant *knows of* or *intended* to be his own lexicographer, the Examiner respectfully requested that he point it out now. After the Examiner has brought this issue to Applicant’s attention and after the Examiner has shown reliance on the *lack* of lexicographic definition(s) to interpret the claims, Applicant’s continued failure to point out any *known* lexicographic definition(s) would clearly be a violation of 37 C.F.R. §1.111(b),<sup>14</sup> and perhaps, Applicant’s duty of candor and good faith under 37 C.F.R. §1.56 which states in part: “(a) ... Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office . . . .” In any event, one point however is clear, such comments by Applicant unmistakably confirm that Applicant has

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<sup>14</sup> For additional guidance on how the USPTO interprets 37 C.F.R. §1.111(b) see *e.g.*: MPEP §818.03(a) quoting §1.111(b) and noting that applicant is required to point out the supposed errors in the next response by stating *why* the Examiner’s position regarding restriction is *substantively* incorrect in order to preserve his or her right to petition; MPEP §2144.03 regarding Official Notice noting that traversal must be made in applicant’s *next response*. “A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well know statement *in the next reply* after the Office action in which the well known statement is made. [Emphasis added.]” Failure to seasonable challenge the official noticed statement *in the very next response* means the statement is interpreted as admitted prior art; and *In re Goodman*, 3 USPQ2d 1866, 1871 (ComrPats 1987) noting the examiners have no authority to waive 37 C.F.R. §1.111(b) and that an applicant is required to point out *any* supposed errors in his next response.



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received notice of the Examiner's factual findings and legal conclusions regarding lexicography invocation and have been given the opportunity to defend against the noticed liabilities.

35. The Examiner notes that Applicant indicated that if confusion still exists regarding lexicography, a telephone call may be necessary. The Examiner agrees. However the Examiner believes that if confusion exists, the confusion is Applicant's and not the Examiner's. The Examiner's position is clear from the record. If Applicant still has confusion, Applicant may call the Examiner at the telephone number indicated below.

***Product-By-Process Terms***

36. It is the Examiner's position that claims 1-22 do not recite any product-by-process claims. See the Second Non Final Office Action, Paragraph No. 19. Applicant has not attempted to overcome the Examiner's position.

***Conclusion***

37. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

38. References are considered pertinent to Applicant's disclosure are found on form PTO-892.

39. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8<sup>th</sup> Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

41. Because this application is now final, Applicant(s) are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of

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patentability (*e.g.* §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

42. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks" (beginning on page 7) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>15</sup> the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert

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<sup>15</sup> *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.

*AJFischer 9/5/04*

Andrew J. Fischer  
Primary Examiner  
Art Unit 3627

AJF  
September 5, 2004